UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 77603741

MARK: LOUIS

77603741

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CORRESPONDENT ADDRESS:
DAVID K FRIEDLAND
FRIEDLAND VINING PA
1500 SAN REMO AVENUE SUITE 200
CORAL GALBELS, FL 33146

APPLICANT: Roach Holdings, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :
18112-1-8010
CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

ISSUE/MAILING DATE:

On June 27, 2012, action on this application was suspended pending the disposition of Cancellation No. 92055700. The proceeding has concluded. The registration that was the subject of the proceeding, Registration No. 3778192, remains valid.[1] Accordingly, the applicant's appeal is herein resumed and the application will be returned to the TTAB.[2]

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION – FINAL MAINTAINED

The FINAL refusal under Trademark Act Section 2(d) is maintained with respect to U.S. Registration No. 3778192. See 15 U.S.C. §1052(d); 37 C.F.R. §2.64(a).

A. Similarity of the Marks

Applicant argued that the registered marks incorporated design elements which distinguish those marks from the applicant's standard character mark.

However, a mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display. TMEP §1207.01(c)(iii); see 37 C.F.R. §2.52(a). Thus, a mark presented in stylized characters or otherwise in special form generally will not avoid likelihood of confusion with a mark in typed or standard characters because the marks could be presented in the same manner of display. See, e.g., Squirtco v. Tomy Corp., 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that "the argument concerning a difference in type style is not

viable where one party asserts rights in no particular display"); In re Melville Corp., 18 USPQ2d 1386, 1387-88 (TTAB 1991); In re Pollio Dairy Prods. Corp., 8 USPQ2d 2012, 2015 (TTAB 1988).

Also, the applicant does not dispute that all the marks in question contain the identical wording LOUIS. Further, the mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. See In re Mighty Leaf Tea, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010); In re Optica Int'l, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). Applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark.

B. Relatedness of the Services

The applicant's services are for "[n]ightclub services" and "[b]ar services".

The registrant's services are for, *inter alia*, entertainment services, and services for "providing of food and drink."

The applicant argued that the applicant and registrant offered their services through distinctly different channels of trade and how consumers encounter such services under distinctly different conditions. *See* Applicant's Response Page 4.

Specifically, the applicant argued that the registrant's "'food and drink' services . . . are at all times offered in connection with cruise ship and/or hotel." The applicant states that the applicant's nightclub and bar services will be "land-faring bar services." *See* Applicant's Response Page 3, 4.

However, the presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. In re Melville Corp., 18 USPQ2d 1386, 1389 (TTAB 1991); McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1899 (TTAB 1989); RE/MAX of Am., Inc. v. Realty Mart, Inc., 207 USPQ 960, 964-65 (TTAB 1980); see TMEP §1207.01(a)(iii).

In a likelihood of confusion analysis, the comparison of the parties' goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. In re Dakin's Miniatures, Inc., 59 USPQ2d 1593, 1595 (TTAB 1999); see Hewlett-Packard Co. v. Packard Press Inc., 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); In re Thor Tech, Inc., 90 USPQ2d 1634, 1638-39 (TTAB 2009); TMEP §1207.01(a)(iii).

In this case, the identification set forth in the cited registration uses broad wording to describe registrant's services and does not contain any limitations as to nature, type, channels of trade or classes of purchasers. Therefore, it is presumed that the registrations encompass all services of the type described, including those in applicant's more specific identification, that the services move in all normal channels of trade, and that they are available to all potential customers. See Citigroup Inc. v. Capital City Bank Grp., Inc., 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); In re Jump Designs LLC, 80 USPQ2d 1370, 1374 (TTAB 2006); In re Elbaum, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii).

That is, the registrant's identification does not limit how the entertainment services, and the services for

"food and drink" services are provided. Indeed, it is more than likely that the registrant's entertainment services are also provided in a nightclub setting, and that the registrant's "food and drink" services are also provided in a bar setting.

Applicant further argues that registrant's services are only offered "in and around Greece, Turkey, Egypt, Italy, France and/or Cyprus." See Applicant's Response Page 6. That is, the applicant argues that its activities are geographically separate from those of registrant; however, applicant seeks a geographically unrestricted registration. The owner of a registration without specified limitations enjoys a presumption of exclusive right to nationwide use of the registered mark under Trademark Act Section 7(b), 15 U.S.C. §1057(b), regardless of its actual extent of use. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1568, 218 USPQ 390, 393 (Fed. Cir. 1983). Therefore, the geographical extent of applicant's and registrant's activities is not relevant to a likelihood of confusion determination.

Thus, taken as a whole, the overall similarities among the marks and the services are so great as to create a likelihood of confusion among potential consumers.

In light of the above, the FINAL refusal to register the mark under Section 2(d) is maintained.

/George M. Lorenzo/
Examining Attorney
Law Office 101
571-272-9367
george.lorenzo@uspto.gov

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All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

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[1] Please note, prior cited U.S. Registration Nos. 3411805, 3436199, 3427026, and 3418512 have been cancelled, and therefore WITHDRAWN.

[2] On June 1, 2012, the applicant instituted its appeal to the Board.